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EXAMINER

MARCANTONI, PAUL D

ART UNIT

PAPER NUMBER

1755

DATE MAILED: 08/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/700,818

Applicant(s)

Berenguer et al.

Examiner

P Marcantoni

Group Art Unit

1755

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 6/17/02
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-3 + 5-12 is/are pending in the application.
- Of the above claim(s) 9, 10, + 12 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-3, 5-8, + 11 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☒ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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Applicant's arguments filed 6/17/02 have been fully considered but they are not persuasive.

Rejection:

Claims 1-3, 5-8, and 11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Patel, Chaux et al., Ricci et al., Keilhofer et al., Cowan et al., Carpenter et al., Carter, or Barat (FR 1505541).

Patel teaches a composition which is added as a viscosifying agent or additive which comprises guar gum (claim 6) and a clay such as sepiolite (claim 9) thus anticipating the instant invention. If not anticipated, the applicants' claimed invention would appear to be obvious to one of ordinary skill in the art because it is essentially a viscosifying agent.

Chaux et al. teach a composition comprising guar gum (claim 3) and an argilla (claim 8) which can be sepiolite (see col.7, lines 25-30) thus anticipating the claimed invention. Although not explicitly stated, the composition can be considered as a whole an additive since it is added to an aqueous medium for hydrosol preparation and thus at least obvious to one of ordinary skill in the art.

Ricci et al. teach a rheological *additive* for aqueous systems comprising a clay such as sepiolite and a polymeric material (see claim 1). Ricci et al. teach that their polymeric material can include guar gum, tragacanth gum and xanthan gum which would all appear to be modified natural gums thus anticipating the claimed invention.

Keilhofer et al. teach a composition comprising a clay mineral such as sepiolite (claim 2) and further including a polysaccharide such as guar gum (claim 8) thus

anticipating the instant invention. Although not explicitly stated, the composition as a whole is an additive that is added as a thickening agent for water based drilling fluids and thus would at least render obvious the applicants' invention to one of ordinary skill in the art.

Cowan et al. teach a cement coated sorbent which is also comprised of guar gum water soluble polymer (col.8, line 35) and a water sorption capacity powdered clay enhancer such as sepiolite (col.8, line 47) thus anticipating the instant invention. The composition as a whole would at least have been obvious to one of ordinary skill in the art since it can be considered a sorbent additive to an animal litter composition.

Carpenter et al. teach a spacer fluid additive comprising sepiolite clay and a natural modified gum such as welan gum (see claim 13) thus anticipating the instant invention. Although not explicitly stated, the composition as a whole is an additive that is added as a thickening agent for water based drilling fluids and thus would at least render obvious the applicants' invention to one of ordinary skill in the art.

Carter teaches a sorbent additive composition comprising a particulate earth clay substrate such as sepiolite (see claim 1 and column 3, lines 54-67, in particular line 65) and a polysaccharide such as guar gum thus anticipating the instant invention. The composition as a whole would at least have been obvious to one of ordinary skill in the art since it can be considered a sorbent additive to an animal litter composition.

FR 1505541 teaches a composition comprising sepiolite and guar gum thus anticipating the instant invention. FR '541 or Barat teaches the composition can be an

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additive or agent for use in forest fire prevention and thus would at least have been obvious to one of ordinary skill in the art.

Response:

The applicants argue for all references that they teach a different usage than that of the instantly claimed invention. In rebuttal, the new use of a known composition is not a patentable distinction.

The applicants also argue for all references that the references teach “conventional sepiolite” whereas for their invention they use “rheological grade” sepiolite. In rebuttal, what is the difference? Are not both types of sepiolite of the same chemical formula and would function the same? It is the examiner’s position that applicants should clarify what exactly the differences are (if any) between these two types of sepiolite. It is also noted that nowhere do the references actually name this type of sepiolite “conventional” sepiolite.

The applicants argue that **Patel** teaches a composition that is “not free of cellulose derivatives” and refer to claim 1 of this reference. In rebuttal, Patel’s claim 1 does meet the limitation of the claimed invention because cellulose ether does not have to be part of the Patel composition. The Markush group language indicates that the chosen polymer could be a combination of the other two components. Namely, a polysaccharide and an acrylamide containing polymer and cellulose ether does not have to be used. Hence, the Patel composition would be free of cellulose derivatives.

The applicants argue that the **Chaux et al.** reference contain water. In rebuttal, the applicants use comprising claim language. Comprising leaves the claim open for the

inclusion of unspecified ingredients even in major amounts. Ex parte Davis et al., 80 USPQ 448 (PTO Bd of App.1948).

The applicants argue intended use for **Ricci** yet it is noted that applicants still use comprising claim language that opens their claims up to the inclusion of unspecified ingredients even in major amounts.

The applicants argue that **Keilhofer** et al. teach a thickener for drilling fluids but not additives for special mortars or gypsum. Again, the new use of a known composition is not a patentable distinction and the applicants have not shown what the difference is between conventional sepiolite and rheological grade sepiolite. Nowhere in the reference does it seem to actually state "conventional" sepiolite so it unclear how applicants arrive at this labeling of the prior art sepiolite.

For **Cowan et al.**, applicants again argue intended use which is not a patentable distinction and label the sepiolite as conventional sepiolite. The examiner notes that the reference never states the word "conventional" but merely states sepiolite which would appear to be inclusive of all sepiolites.

The applicants arguments are the same for the remaining reference and argue intended use and the grade of sepiolite utilized. In rebuttal, the new use of a known composition is not a patentable distinction and the references do not explicitly state conventional sepiolite. There appears to be no difference between conventional sepiolite and rheological grade sepiolite absent evidence to the contrary. Even if not anticipated, the prior art still teaches the same ingredients in what would appear to be

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overlapping ranges of amounts and this would thus render applicants' invention obvious to one of ordinary skill in the art.

The applicants argue *In re Spinnoble* but it is the examiner's position that a more relevant case law would have been *In re Spada* or *Titanium Metals Corp. v Banner*. This can be found in MPEP 2100. Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 562 F.2d at 1255, 195 USPQ at 433. See also *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (Claims were directed to a titanium alloy containing 0.2-0.4% Mo and 0.6-0.9% Ni having corrosion resistance. A Russian article disclosed a titanium alloy containing 0.25% Mo and 0.75% Ni but was silent as to corrosion resistance. The Federal Circuit held that the claim was anticipated because the percentages of Mo and Ni were squarely within the claimed ranges. The court went on to say that it was immaterial what properties the alloys had or who discovered the

properties because the composition is the same and thus must necessarily exhibit the properties.).

The applicants also argue "combination" of references. In rebuttal, the examiner has used no combination rejection (ie A in view of B) but only used the references individually which on their own merits renders applicants' invention anticipated or at least obvious to one of ordinary skill in the art.

The applicants also argue that the examiner argues impermissible hindsight. It is unclear how applicants can hold this position since all references cited contain the same components as claimed by applicants for their additive. There is no hindsight in simply using the basic teaching of the prior art references. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Finally, all rejections under 35 USC 112 have been withdrawn upon consideration of applicants' remarks and amendment to their claims. Applicants also use improper Markush language in claim 1 using "selected from" instead of the commonly accepted --selected from the group consisting of---.

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THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is (703)-308-1196. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on (703) 308-3823. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9310 for regular communications and (703)-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.



Paul Marcantoni
Primary Examiner
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